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U.S. Application No. 09/748,905 Examiner SHELTON, Art Unit 2611  
Amendment in Response to First Office Action

### REMARKS

In response to the final Office Action dated July 23, 2004, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the amended claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") objected to the originally-filed Abstract. The Office also objected to claim 12 for antecedent errors. The Office rejected claims 1-3, 8, and 9 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,016,141 to Knudson *et al.* Claims 21-27 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,604,240 to Ellis *et al.* Claims 4 and 5 were rejected under 35 U.S.C. § 103 (a) as being obvious over Knudson in view of U.S. Patent 6,732,367 to Ellis *et al.* Claims 6 and 7 were rejected under 35 U.S.C. § 103 (a) as being obvious over Knudson in view of U.S. Patent 6,604,240 to Ellis *et al.* Claims 10-19 and 29 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,604,240 in view of Knudson. Claim 20 was rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,604,240 to Ellis *et al.* in view of Knudson and further in view of U.S. Patent 6,057,872 to Candelore. Claim 28 was rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,604,240 to Ellis *et al.* in view of Candelore. The Assignee shows, however, that the amended claims are patentably distinguishable over the cited prior art, and the Assignee thus respectfully submits that the pending claims are ready for allowance.

### Objection to the Abstract

The Office objected to the originally-filed Abstract for exceeding 150 words. The Assignee replaces the originally-filed Abstract with a shorter version not exceeding the work limit.

### Objection to Claim 12

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The Office objected to claim 12 for antecedent errors. Claim 12 has been amended to correct this antecedent error. Examiner Shelton is thanked for the keen eye.

**Rejection of Claims 1-3, 8, and 9 under 35 U.S.C. § 102 (e) to Knudson**

The Office rejected claims 1-3, 8, and 9 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,016,141 to *Knudson*. A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, amended, independent claims 1 and 8, and thus the dependent claims thereunder, are patentably distinguishable over *Knudson*. The reference to *Knudson* does not anticipate independent claims 1 and 8, so the Assignee respectfully requests that Examiner Shelton remove the 35 U.S.C. § 102 (e) rejection.

Independent claims 1 and 8 have been amended. Claim 1, for example, now includes features for displaying a schedule. This schedule allows a package to be automatically recorded. As claim 1 now recites, subscribers are displayed information concerning "*a schedule to automatically record the package.*" Independent claim 8 includes the similar feature of "allowing the user to command the EPG selectively to *display a schedule to automatically record an individual event within a package.*"

*Knudson* is completely silent to this schedule. *Knudson* completely fails to realize that a schedule can be displayed that allows subscribers to schedule automatic recording of events and/or packages. *Knudson* does mention a "videocassette recorder, so that the user may record programs" (U.S. Patent 6,016,141 to *Knudson* at column 4, lines 3-5). *Knudson* also states that "[p]rogram recording and other features may be controlled by set-top box using control path" (*Knudson* at column 4, lines 5-7). *Knudson*, however, fails to describe the claim 1 feature "*subscribers are displayed information concerning a schedule to automatically record the package.*" *Knudson* also fails to describe the claim 8 feature "*allowing the user to command the EPG selectively to display a schedule to automatically record an individual event within a*

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*package.*" Because *Knudson* fails to teach these features, *Knudson* cannot anticipate independent claims 1 and 8. The Assignee, then, respectfully asks Examiner Shelton to remove the § 102 rejection and to allow the pending claims.

**Rejection of Claims 21-27 under 35 U.S.C. § 102 (e) to Ellis ('240)**

Claims 21-27 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,604,240 to Ellis *et al.* Claims 21-27, however, have been canceled, so the rejection is moot.

**Rejection of Claims 4 & 5 under 35 U.S.C. § 103 (a)**

Claims 4 and 5 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Knudson* in view of U.S. Patent 6,732,367 to Ellis *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). Because the proposed combination of *Knudson* and *Ellis* fails to teach or suggest all the limitations of independent claim 1, and thus dependent claims 4 and 5, the *prima facie* case of obviousness must fail.

Independent claim 1, and thus dependent claims 4 and 5, is not obvious in view of *Knudson* and *Ellis*. Independent claim 1 includes features for displaying a schedule that allows a package to be automatically recorded. As amended claim 1 now recites, subscribers are displayed information concerning "*a schedule to automatically record the package.*" The proposed combination of *Knudson* and *Ellis*, then, in no way teaches or suggests the elements of claim 1 and, thus, dependent claims 4 and 5. One of ordinary skill in the art, then, would not find it obvious to combine the teachings of *Knudson* and *Ellis* to display "*a schedule to automatically*

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*record the package.*" Because the proposed combination of *Knudson* and *Ellis* does not teach or suggest all the claim limitations, the Assignee respectfully requests removal of the rejection.

**Rejection of Claims 6 and 7 under 35 U.S.C. § 103 (a)**

Claims 6 and 7 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Knudson* in view of U.S. Patent 6,604,240 to *Ellis et al.* Because the proposed combination of *Knudson* and *Ellis* fails to teach or suggest all the limitations of independent claim 1, and thus dependent claims 6 and 7, the *prima facie* case of obviousness must fail. Independent claim 1, as explained above, now recites that subscribers are displayed information concerning "*a schedule to automatically record the package.*" The proposed combination of *Knudson* and *Ellis* fails to teach or suggest the elements of claim 1 and, thus, dependent claims 6 and 7. One of ordinary skill in the art, then, would not find it obvious to combine the teachings of *Knudson* and *Ellis* to display "*a schedule to automatically record the package.*" Because the proposed combination of *Knudson* and *Ellis* does not teach or suggest all the claim limitations, the Assignee respectfully requests removal of the rejection.

**Rejection of Claims 10-19 and 29 under 35 U.S.C. § 103 (a)**

Claims 10-19 and 29 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,604,240 to *Ellis et al.* in view of *Knudson*. First, claim 29 has been canceled, so the rejection of claim 29 is moot. Second, independent claims 10 and 15 both include features not taught or suggested by the proposed combination of *Ellis* and *Knudson*. Independent claim 10, for example, includes an electronic programming guide ("EPG") comprising "*a screen showing a schedule to automatically record the two or more separate programming events.*" Independent claim 15 similarly includes "*displaying a schedule that allows the subscriber to schedule an automatic recording of the package.*" Because the proposed combination of *Ellis* and *Knudson* fails to teach or suggest all the limitations of independent claims 10 and 15, the *prima facie* case of obviousness must fail. One of ordinary skill in the art, then, would not find it obvious to combine/modify the teachings of *Ellis* and *Knudson* to obviate claims 10 and 15. Because the

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proposed combination of *Ellis* and *Knudson* does not teach or suggest all the claim limitations, the Assignee respectfully requests removal of the rejection.

**Rejection of Claim 20 under 35 U.S.C. § 103 (a)**

Claim 20 was rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,604,240 to *Ellis et al.* in view of *Knudson* and further in view of U.S. Patent 6,057,872 to *Candelore*. Claim 20 ultimately depends from independent claim 15 and, thus, includes the same patentable feature "*displaying a schedule that allows the subscriber to schedule an automatic recording of the package.*" Because the proposed combination of *Ellis*, *Knudson*, and *Candelore* fails to teach or suggest all the limitations of independent claim 15, the *prima facie* case of obviousness must fail. One of ordinary skill in the art, then, would not find it obvious to combine/modify the teachings of *Ellis*, *Knudson*, and *Candelore* to obviate claim 15. Because the proposed combination of *Ellis*, *Knudson*, and *Candelore* does not teach or suggest all the claim limitations, the Assignee respectfully requests removal of the rejection.

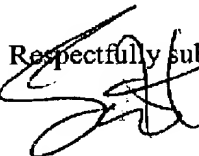
**Rejection of Claim 28 under 35 U.S.C. § 103 (a)**

Claim 28 was rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 6,604,240 to *Ellis et al.* in view of *Candelore*. Claim 28, however, has been canceled, so the rejection is moot.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,



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